



Options available within the IP system to promote minor inventions

WIPO Regional Seminar on the
Legislative, Economic and
Policy Aspects of Utility Models
Protection System

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Minor inventions: which protection?

- Patents
- Patents of addition
- Utility Models
- Trade Secrets
- Designs

Patent (Protection)

- Patent (exclusive right) granted on a **territorial** basis
 - Country-by-country (ex. AU, BR, CN, JP, KR, US)
 - Region (ex. European Patent Office)
- Protection of **20 years** from the filing date (subject to a maintenance fee)
- Need to fulfill certain **conditions** to enjoy protection

Patent (Disclosure)

- An invention must be disclosed in a manner **sufficiently clear and complete** so that the invention can be carried out by a person skilled in the art
- Patent information is disclosed **globally** (ex. Internet)
 - Know what already exists
 - Identify tech. available under a license
 - Know whether a given tech. is in the public domain

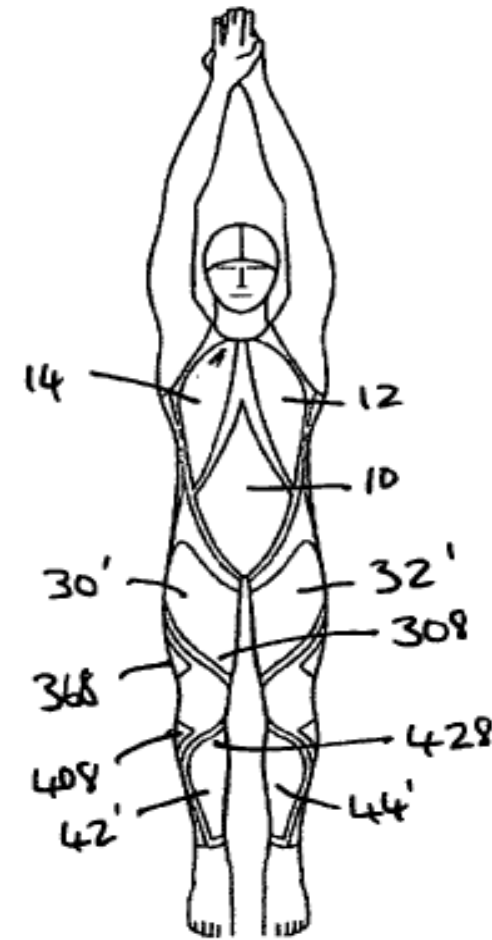


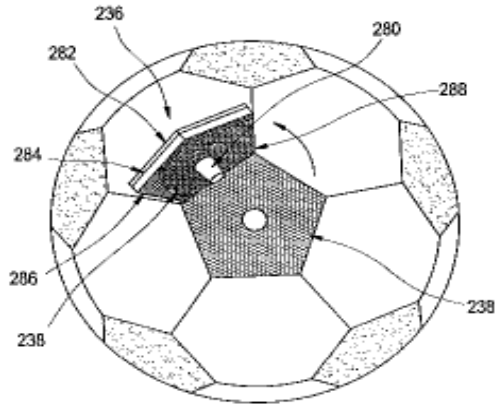
FIG. 4

Patent application
GB 2,444,804 A

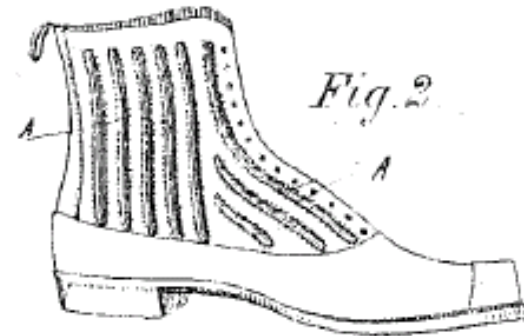
Patentable subject matter

- An **invention**
- A **product** or a **process**
- All fields of technology
- Exceptions:
 - Discoveries, scientific theories, mathematical methods, mental methods
 - Contrary to public order or morality
 - Diagnostic, therapeutic and surgical methods for the treatment of humans and animals
 - Plants and animals (except microorganisms)

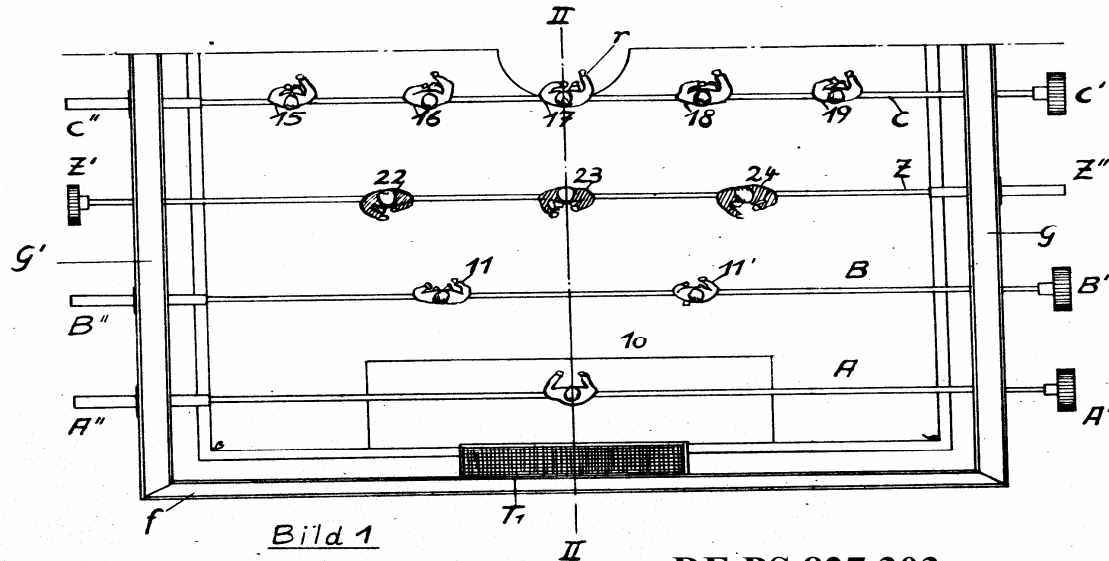
Patentable Subject Matter



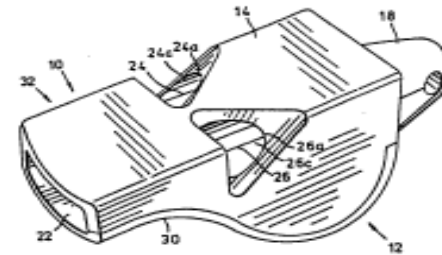
US 2003/0130076 A1



GB 1887-15,836



DE PS 827,303



EP0302645

What kind of invention can be protected?

- Patentable subject matter
- Novelty
 - New characteristics which are not known in the body of existing knowledge (“ prior art”)
- Inventive step (Non-obviousness)
 - Having regard to the prior art, the invention is not obvious to a person skilled in the art
- Industrial applicability (Utility)

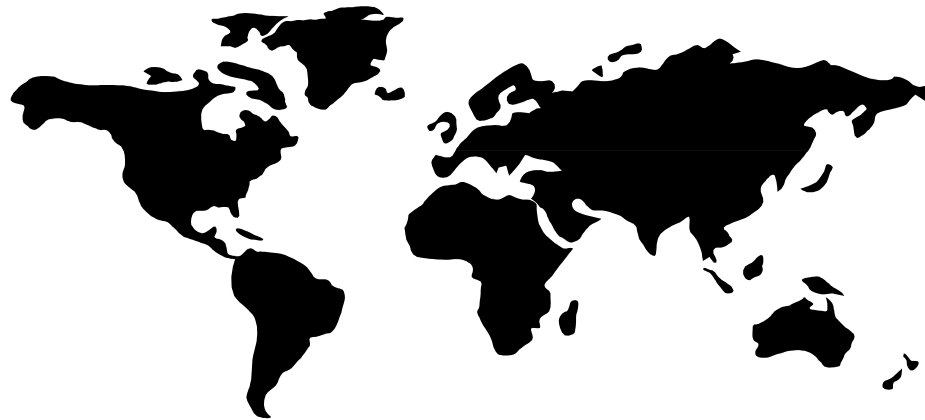
What right does a patent owner have?

- An exclusive right to **prevent others** from using, making, selling, importing for those purposes, the invention **without the patent owner's consent**
 - may **give permission to**, or **license**, other parties to use the invention
 - may **sell** the right to someone else
- NOT a right to commercialization
- **Limitations** to the rights to balance the interests of the patent owner and third parties (public)
 - ex. - private and non-commercial use
 - research and experiments
 - compulsory license
- After the expiration of the patent term: public domain

International norm setting

- Principle -

- Territoriality
- Independence of patents obtained for the same invention in different countries



Patents of addition

- Form of additional protection introduced in many countries since the 19th century
- In this period no minimum standard requirements for patents
- Protection of something “additional” in comparison to a main invention → invention claiming to be an improvement or modification of a previous invention

Reason behind the system of PA

- “Improvement”: technology that builds directly upon a basic patent
- Inventive process: ongoing process, which often continues after the application for a patent
- Need to grant to the patent applicant/patent holder the occasion to extend the protection to the improvement of a main invention

Relationship main patent-patent of addition (1)

Strict relationship between main invention and improvement invention protected through a patent of addition

- Person entitled to apply for a patent of addition
- Period of protection
- Fee

Relationship main patent-patent of addition (2)

- Person entitled to apply for a patent of addition: only the holder of the main patent/patent application (in the UM system everybody can apply for a UM concerning an improvement invention)
- Period of protection: the same of the main patent (UM: the periods of protection are independent)
- Fee: are due only for one invention (UM: are due for the two inventions)

Requirements of the improvement invention

- Often the same of the main invention: i.e. inventive step, novelty and industrial applicability (e.g. in Germany)
- In certain cases inventive step is not required (for example in Australia and New Zealand)

Patents of addition and Utility Models

Patents of addition: procedure to grant the patent applicant/holder to extend the protection to an improvement of the main invention:

- save money for the fee (only one fee is due)
- only one application
- extension of the protection to something otherwise not patentable (in countries where inventive step is not required)

Utility Models:

System to protect minor inventions open to everybody →
Independent title of protection

Undisclosed information

Ex. manufacturing processes, sales methods, distribution methods, consumer profiles, advertising strategies, lists of suppliers and clients

Criteria

- The information must be secret
- It must have commercial value because it is a secret
- It must have been subject to reasonable steps by the rightful holder of the information to keep it secret

Prevent unauthorized use of protected undisclosed information

Protection of undisclosed information - comparison with patent/utility model protection -

Potential advantage

- No time limit
- No registration required
- Immediate effect
- Commercial information can be protected

Potential disadvantage

- Possibility of reverse engineering
- May be patented by an independent third party
- Once the information is made public, secrecy is lost
- Difficult to enforce

Designs

- Protection of independently created industrial designs that are new or original.
- Members may provide that such protection shall not extend to designs dictated **essentially by technical or functional considerations**.
- The right to prevent third parties not having the owner's consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes

THANK YOU!

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